

REMARKS

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 2-21 are pending in the application. Several claims have been amended to better define the claimed invention. The amended claims find solid support in the application as filed. No new matter has been introduced through the foregoing amendments.

The Examiner's withdrawal of the finality of the previous action is noted.

The claim objections are believed overcome in view of the above amendments.

The *35 U.S.C. 112, first paragraph* rejection of claim 4 under the enablement requirement of *35 U.S.C. 112, first paragraph* is traversed, because the Examiner has failed to follow proper USPTO procedure and practice.

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure) (emphasis added). *See MPEP*, section 2164.04.

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976) (emphasis added). *See MPEP*, section 2164.01.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

(A) The breadth of the claims;

- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of non-enablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407 (emphasis added). See MPEP, section 2164.01(a).

The Examiner's *35 U.S.C. 112, first paragraph* rejection of claim 4 has failed to provide an analysis of at least factors (D) and (F). Applicants respectfully submit that the ordinary skill in the related art is sufficiently high to enable a skilled artisan to make and use the claimed invention *without undue experimentation*, based on at least the disclosure provided at the paragraph bridging pages 5-6 of the specification. The passage includes a definition of the term "average kinetic frictional force" that must be used in interpreting claim 4. The composition of the fibers have been set forth in claim 4, i.e., plastic elastomer and thermoplastic material.

Withdrawal of the *35 U.S.C. 112, first paragraph* rejection of claim 4 in view of the above is now believed appropriate and therefore respectfully requested.

The art rejections of all claims as being obvious over newly discovered and applied references, namely, U.S. Patent No. 6,755,809 to *Kline* and U.S. Patent Application Publication No. 2003/0124928 in the name of *Sherrod* are traversed for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art,

not in applicant's disclosure. *See MPEP*, section 2143 quoting *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that the Examiner's rejection has failed to meet, at least, the first and third criteria.

As to the first criterion, the Examiner alleges that it would have been obvious to apply the *Sherrod* skid-resistant coating on the outer surface of the backsheet of the *Kline* garment to arrive at the claimed invention of independent claims 4, 11 and 13. Applicants respectfully disagree. The *Sherrod* skid-resistant coating is arranged to contact with external objects to maintain the garment in use. *See Sherrod* at Abstract and paragraphs [0001] and [0002]. Thus, it would have been obvious, if at all, to apply the *Sherrod* skid-resistant coating only to the portion of the *Kline* backsheet that is contactable with external objects. It would not have been obvious to apply the *Sherrod* skid-resistant coating in regions arranged for contact between internal parts (i.e., front and rear wings) as presently claimed. Thus, the applied references are not properly combinable in the manner proposed by the Examiner.

As to the third criterion, Applicants note that the essence of the rejection is the Examiner's reliance on the *Sherrod* non-adhesive skid-resistant coating 30 on outer surface 42 of backsheet 28 shown in Fig. 2 of the reference. Independent claims 4, 11 and amended independent claim 13 all recite that the claimed anti-slip zone includes elastic and inelastic fibers. Applicants respectfully submit that the *Sherrod* skid-resistant coating is not of a fibrous nature.

A person of ordinary skill in the art would understand from the disclosure in paragraphs [0040], [0041] and [0042] of *Sherrod* that the materials to be used in forming the *Sherrod* skid-resistant coating must be coatable, that is, the materials must be fluidized and have a latex- or emulsion- or liquid-like type. This is also evident from paragraph [0030] in which *Sherrod* states “[t]he material suitable for the coating 30 can be any latex and hot-melt” (emphasis added). Accordingly, a person of ordinary skill in the art would recognize that the *Sherrod* skid-resistant

coating does not comprise any fibers and, hence, is different from the anti-slip zones in the claimed invention which is defined by a fibrous mixture of elastic fibers and inelastic fibers.

It should be noted here that the claimed anti-slip zones would exhibit a higher kinetic frictional force or coefficient than the *Sherrod* skid-resistant coating, because the elastic and inelastic fibers in the claimed anti-slip zones form a “rougher” surface whereas the *Sherrod* skid-resistant coating would probably have a “smoother” surface.

Thus, even if *Sherrod* was properly combinable with *Kline*, which Applicants contend to the contrary for the reasons advanced above, the resulting article would fail to teach or disclose all limitations of the independent claims.

Withdrawal of the art rejections in view of the above is now believed appropriate and therefore respectfully requested.

Each of the Examiner’s rejections has been traversed/overcome. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant’s attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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